

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Daniel E. Cooney	:	Conf. No.: 7830
		:	
Application No.:	10/799,308	:	Group Art Unit: 2855
		:	
Filed:	March 13, 2004	:	Examiner: Octavia L. DAVIS
		:	

For: APPROACH FOR INDICATING THE OCCURRENCE OF A MECHANICAL IMPACT
ON A MATERIAL, SUCH AS A LOW-DUCTILITY COMPOSITE MATERIAL

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please consider the following Response for the above-referenced Application.

Claims 1-6 and 8-24 are pending, and all claims are subject to a restriction. In response, Applicant elects the claims of Group I, with traverse, and the following remarks are submitted. Reconsideration of the restriction is requested.

The reasons for the traverse follow.

1. MPEP 803 I provides that:

"There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP 802.01, 806.06, 808.01) or distinct as claimed (see MPEP 806.05-806.05(j)).

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP 803.02, 808, and 808.02)."

(Part (A) is contrary to law but will be accepted *arguendo* for sections 2-3 below.)

Neither of these criteria is met by the present restriction; see sections 2 and 3 below.

2. The explanation of the restriction asserts that: "Inventions I-III are related as subcombinations disclosed as usable together in a single combination."

There is no legal basis cited for restricting claims that are argued to be "subcombinations disclosed as usable together in a single combination." No MPEP section is cited as the basis for the restriction of "subcombinations disclosed as usable together in a single combination," and Applicant can find no such section. MPEP 806.05-806.05(j), referenced in MPEP 803 I (A), cited above in section 1, has no provision for restriction of "subcombinations disclosed as usable together in a single combination." If the restriction is maintained, such a legal basis must be provided because the arguments of the explanation must be tested against the legal requirements.

3. MPEP 803 I (B) provides that the restriction must establish that "There would be a serious burden on the examiner if restriction is not required."

MPEP 803 II provides that the Applicant may rebut the Examiner's position.

All of these claims that are now subject to restriction have already been examined, not once but twice. No question of "serious burden" was raised in relation to the two prior examinations. See Office Actions of August 10, 2005, and April 4, 2006. The claims were not amended in the Response to the Office Action of April 4, 2006, so nothing has happened in the claim structure that would necessitate making a restriction at this point after two prior examinations. By these two prior examinations, the Examiner is either admitting that the prior examinations were performed without serious burden on the examiner, or that the prior examinations were not properly performed. Clarification is required if the restriction is maintained, because it is not evident what serious burden is imposed on the Examiner at this late stage in prosecution, and when the claims have not been amended in the prior submission.

4. It is asserted that the article and the method have acquired separate status in the art, based upon different patent office classifications. In fact, they have only a separate status in the patent office classification system, and there is no showing that they have a separate status in the art. Patent office art classifications are administrative conveniences

developed in the patent office, with the goal of justifying restriction requirements. There has been no showing that they bear any relation to the manner in which those skilled in the art view the art. Hence, there is no support for the assertion that they "have acquired a separate status in the art." If the Examiner intends to rely upon this concept of separate status in the art to support the restriction, Applicant asks that the Examiner set forth the factual basis to demonstrate that those skilled in the art, rather than those who establish the patent office classification system, would view the article and the method as having acquired separate status. In any event, the search of the art has already been performed by the Examiner

5. The restriction is made pursuant to 35 USC 121. The claims must be shown to be "independent and distinct" to maintain the restriction, 35 USC 121, 37 CFR 1.141, MPEP 802. Since this requirement is statutory, it is not proper to interpret the statute in any other fashion. 35 USC 121 provides no basis for restriction on the ground that the patent office has classified the inventions of the various claims into different art classifications and search fields.

In this case, there is no showing that the inventions of the three Groups are independent and distinct, and the claims are not in fact independent and distinct.

Applicant asks that the Examiner reconsider and withdraw the restriction.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully requests reconsideration of the Application and withdrawal of all outstanding objections and rejections. Applicant respectfully submits that the claims are not anticipated by, nor rendered obvious in view of; the cited art either alone or in combination and thus, are in condition for allowance. Thus, Applicant requests allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant's undersigned representative.

This Response has been filed within one (1) month of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that